



UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JAN - 3 2003

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In re Application of :
Joseph Tyler et al :
Serial No.: 09/691,429 : PETITION DECISION
Filed: October 18, 2000 :
Attorney Docket No.: 1932.2005-002 :

This is in response to applicants' petition under 37 CFR 1.181, filed October 4, 2002, requesting withdrawal of Finality of the last Office action. The delay in acting on this petition is regretted.

A review of the file history shows that this application was filed October 18, 2000, and presented claims 1-21 for examination. In a first Office action, mailed January 2, 2002, the examiner rejected claims 1-8, 12 and 19-21 under 35 U.S.C. 102(b) as anticipated by Holmes-Farley. Claims 1-21 were rejected under 35 U.S.C. 103(a) as obvious over Holmes-Farley in view of Renegal in connection with the specification and Physicians Desk Reference. Claim 4 was further rejected under 35 U.S.C. 112, second paragraph, as indefinite.

Applicants replied on April 16, 2002 (Certificate of Mailing dated April 12, 2002), with an extension of time and fee and by canceling claim 1, amending claims 2-19 and adding claims 22-23. Appropriate arguments to overcome the rejections were made.

The examiner then mailed a Final Office action to applicants on July 29, 2002. The examiner withdrew claims 19-21 from further consideration as being directed to a non-elected invention based on the inclusion of a pharmaceutically active agent. Claims 2-18 were rejected under 35 U.S.C. 103(a) as unpatentable over Holmes-Farley and John et al. Claim 22 was rejected under 35 U.S.C. 103(a) as unpatentable over Holmes-Farley in view of the specification. Claim 23 was indicated allowable. The action was made Final without any specific reason therefor being given.

DISCUSSION

Applicants point out that the Office action contains a new ground of rejection not previously set forth and not necessitated by amendments to the claims and that the finality is, therefore, premature. The new rejection pointed out is the addition of the John et al reference to Holmes-

Farley under 35 U.S.C. 103(a). The previous rejection under 35 U.S.C. 103(a) combined Holmes-Farley and Renegal. John et al was cited by applicants in an IDS which is indicated as having been considered by the examiner prior to first Office action. Thus John et al could have been applied in a rejection in the first Office action, but was not. Applicants further point out that the present claims contain all of the limitations of claims 13-16 directed to a tablet comprising a core and coating. Thus applicants' amendments did not necessitate the new ground of rejection. The Renegal reference was withdrawn when it was pointed out that it did not qualify as a reference since it only became available after applicants' priority date.

A review of the claims as originally presented shows that claims to a tablet core and claims to a tablet core with a coating were presented for examination as well as claims to a compressed tablet of the same components. All of the claims were examined and rejected as noted above. Claims 13-16, specifically directed to a tablet core and a coating were rejected over Holmes-Farley in view of Renegal. The response to the first Office action amended all claims to claim a tablet core and coating thereon. Claims 19-21 were amended to a compressed tablet comprising a pharmaceutically effective agent and the polyalkyl amine (tablet core component). Claims 2-18 and 22 are now rejected over Holmes-Farley in view of John et al, clearly a different rejection of claims 13-16 than set forth in the previous Office action, but which rejection could have been made in the previous Office action. Therefor, making the Office action Final was improper in accordance with M.P.E.P. 706.07(a).

DECISION

Applicants' petition is **GRANTED**. The Finality of the last Office action, mailed July 29, 2002, is withdrawn. The Office action, which appears to be a complete action, is not withdrawn.

Applicants remain under obligation to reply to the Office action within the time period set therein or as may be extended in accordance with 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

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